

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

Yukitaka SHIMIZU et al.

Application No.:	10/565,853	Confirmation No.:	8106
Filed:	January 26, 2006	Art Unit:	3685
For:	ACCOUNTING SYSTEM CONTENT REPRODUCTION DEVICE, LICENSE SALES DEVICE, PROGRAM AND RECORDING MEDIUM	Examiner:	K. Muhammad

PETITION UNDER 37 C.R.R. § 1.181(a)(3)

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to invoke the supervisory authority of the Director in the above-identified application to have the Office Action dated October 28, 2010 withdrawn and to have this application transferred to a new Examiner for the reasons discussed in detail below. The supervisory authority of the Director is further sought in order to ensure that the Supervisory Patent Examiner (SPE) complies with MPEP § 707.02 relative to ensuring that any subsequent Office Action in this application is a non-final Action that sets forth a proper Restriction Requirement based upon unity of invention that properly considers claims 34 and 35, that satisfies the completeness requirement of 37 C.F.R. § 1.104(c)(2) as to any prior art rejection made, that insures that the requirement to answer the substance of applicants' arguments in MPEP § 707.07(f) is fully met as to all repeated rejections, and that makes no rejections of canceled claims 26 and 27.

STATEMENT OF THE FACTS

On July 28, 2008, a Restriction Requirement was mailed that incorrectly applied the criteria of distinctness from MPEP § 800 instead of applying the "unity of invention" criteria of MPEP § 1893.03(d) and MPEP § 1850 that was required as to this application filed in accordance with 35 U.S.C. § 371 (entered the national stage from an international application). A Reply to this improper Restriction Requirement was filed on August 27, 2008, that pointed out the error in relying on the criteria of distinctness from MPEP § 800 instead of applying the "unity of invention" criteria of MPEP § 1893.03(d) and MPDP § 1850 and electing, with traverse, Group I, Claims 14, 16, 17, 20-23, 26, 27, 29 and 30 for prosecution.

The Examiner assigned to this above-noted application then transmitted the non-final Office Action dated December 24, 2008 to Applicants. This initial non-final Action (dated December 24, 2008) was noted to be clearly improper in many respects in the first response under 37 C.F.R. § 1.111 that was filed March 24, 2009.

One such improper aspect of the above-noted initial non-final Office Action was noted to be the failure thereof to indicate any reconsideration of the Restriction Requirement mailed July 28, 2008, based upon the traverse of this requirement included with the response filed August 27, 2008. This first response further noted 37 C.F.R. § 1.143 had been violated by not repeating the traversed requirement and in not making the traversed Requirement final. This last point was noted to be important as it impacted on the right of the applicants to file a petition for review of the Requirement under 37 C.F.R. § 1.144.

A second improper aspect of this December 24, 2008 initial Office Action that was noted in the first response was that the rejection therein of pending claims 14, 16, 20, 22, and 23 under the second paragraph of 35 U.S.C. § 112 was improper for a variety of reasons. In this regard, the lack of any explanation or examples in the December 24, 2008 initial Office Action was noted as were the provisions of MPEP §§ 2173.01 and 2173.02 that permitted the use of functional language.

The points as to improprieties raised in the March 24, 2009 response notwithstanding, the PTO issued a final Office Action on August 6, 2009. This final Office Action was noted to be clearly improper at least as to the repeated Restriction Requirement in the response filed September 30, 2009, as well as in the Petition under 37 C.F.R. § 1.144 that was simultaneously filed therewith. In addition, the September 30, 2009 response noted the improper nature of the

repetition of rejections from the December 24, 2008 Office Action with no attempt having been made to answer the substance of any of the arguments filed with the March 24, 2009 response. On October 29, 2009, an Advisory Action was mailed that indicated that the response filed September 30, 2009, would be entered without any indication of the status of the Petition filed September 30, 2009 or any proper consideration of the improper Restriction Requirement and the failure to answer the substance of the repeated arguments as noted above.

After repeated telephone calls to the Examiner and his Supervisor, Applicants' representatives were informed that the improper nature of the restriction requirement had been reconsidered in light of the Petition, and that the outstanding final Office Action of August 6, 2009 and the Restriction Requirement therein would be withdrawn and that a replacement Action including a Restriction Requirement based upon "unity of invention" would be forthcoming with the Petition being then treated as moot.

The first replacement Office Action (dated February 3, 2010) was received but was noted to be clearly improper in many respects. For example, the first replacement Action had been improperly made final even though it added a new ground of rejection as to claims 14, 16, 17, 20-23, 26, 27, 29, and 30 under 35 U.S.C. § 101, which new ground of rejection was clearly not necessitated by any claim amendment. This first replacement Action further completely failed to address the arguments raised in the Amendments filed September 30, 2009 and March 24, 2009 as to rejections being repeated in the replacement Action. A further deficiency was noted as to claims 34 and 35 (that had been added to replace claims 26 and 27 by the Amendment filed on March 2009) that had only been noted in item 6 of the "Office Action Summary" sheet as being rejected without any specific rejection being made in the body of the first replacement Action.

Accordingly, a further telephone call was placed to point out errors in the first replacement Action of February 3, 2010, and this first replacement Action was withdrawn and replaced by the second replacement final Action dated March 4, 2010. While that second replacement final Action did at least remove the improper rejection of claims 14, 16, 17, 20-23, 26, 27, 29, and 30 under 35 U.S.C. § 101, it corrected none of the other clear Action errors noted above.

In this regard, the second replacement final Action dated March 4, 2010, still violated the completeness requirement of 37 C.F.R. § 1.104(c)(2), it still violated the requirement to answer the substance of applicant's arguments of MPEP § 707.07(f), and it still violated the MPEP §

707.07(d) requirements as to rejection contents. This second replacement final Action dated March 4, 2010, also failed to adequately consider that independent claims 14 and 16 of Group I include far more in common with independent claim 15 of Group II and independent claim 18 of Group III than just "applying license to devices that provide content." For example, each of independent claims 14-16 and 18 recited an "accounting server" to receive at least "content ID" and "accounting ID" to perform an accounting and to return an indication of a successful accounting after subtracting an appropriate amount from stored money information.

Item 6 of the Office Action Summary (the PTOL-326 attached to the second replacement final Action) indicated that claims 34 and 35 were "rejected" but this statement standing alone clearly failed to meet the requirements of 37 C.F.R. § 1.104(c)(2). Furthermore, the body of the second replacement final Action did not set forth any specific rejection of claims 34 and 35. Not only does this violate 37 C.F.R. § 1.104(c)(2), it also violates MPEP § 707.07(d).

Further lacking from the second replacement final Action of March 4, 2010, was any attempt to comply with MPEP § 707.07(f) that notes that when "the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it" (emphasis added). For example, the included rejection of claims 14, 16, 20, 22, 23, and 26 (a canceled claim) under the second paragraph of 35 U.S.C. § 112 repeated this rejection and the rationales offered for it (from paragraphs 7-13 of the Office Action dated December 24, 2008) as paragraphs 12-19 of the second replacement outstanding final Action. However, the clearly defective reasoning in repeated paragraphs 7-13 of the Office Action dated December 24, 2008 was previously traversed in the Amendment filed March 24, 2009 and the amendment filed September 30, 2009, which traversals continue to be unanswered even in the third replacement Final Action dated October 28, 2010, that resulted from the Decision on Petition dated September 9, 2010.

Even though the Petition filed June 3, 2010, was granted as to withdrawing the second replacement final Action of March 4, 2010, the request that "all of the above-noted inadequacies are corrected in any subsequent Action" was ignored by this Decision that was apparently authored by the SPE whose initials (CLH) appear below the signature of the Director of Technology Center 3600.

Besides the Decision dated September 9, 2010 not responding to the above-noted request for corrections of the previously noted inadequacies, the request for transfer to a new Examiner

was denied based upon an allegation that the last improper final Action of March 4, 2010 was in accordance with 37 C.F.R. § 1.104(c)(2) and MPEP § 707.07(d) and MPEP § 707(f), even though there was a clear violation of both 37 C.F.R. § 1.104(c)(2) and MPEP § 707.07(d) in terms of the noted failure to provide any specially stated rejection of claims 34 and 35. This allegation is further clearly erroneous as to MPEP § 707(f) in light of the repetition of the previously stated positions and rejection under the second paragraph of 35 U.S.C. § 112 at pages 4-7 (sections 9-19) of the March 4, 2010 Action. This repetition of the previous rejection clearly violated MPEP § 707(f) as it made no attempt to answer any of the arguments in the response filed June 3, 2010, or in the earlier responses, that traversed this rejection.

The present outstanding final Action continues the above-noted unacceptable violations of 37 C.F.R. § 1.104(c)(2), MPEP §§ 707.07(d) and (f) as well as adding a violation of MPEP § 706.07(a). In this last regard, the present outstanding final Action adds a new 35 U.S.C. § 102 rejection of claims 34 and 35 and a new 35 U.S.C. § 103 rejection of claims 34 and 35. These new rejections of claims 34 and 35 were clearly not necessitated by any amendment that has been made to these claims that were introduced long ago.

In addition to these above-noted clear errors, the outstanding final Action contains conflicting statement as to what previous improper final Actions have been withdrawn. In this respect, page 9, item 16, only indicates withdrawal of "the 2 previous final rejection dated 8/6/2009 and 2/2/2010." On the other hand page 6, item 9, indicates that "the prior final office actions have been withdrawn" which would appear to imply that the last improper final Action of March 4, 2010, has also been withdrawn.

The latest outstanding final Action also improperly repeats many of the errors found in the withdrawn previous improper final Actions. In this regard the errors in the Restriction Requirement noted in the response filed June 3, 2010, have been repeated. This is particularly unacceptable as to the continued listing of canceled claims 26 and 27 with the claims of Group I while claims 34 and 35 are not grouped at all. The continued inadequate consideration of all claimed special technical features is a further repeated error that has been previously noted and that has been repeated in the outstanding final Action.

The Restriction Requirement further errs by listing Groups I-V as being restrictable based upon differences in functional limitations. Even though a Restriction was made based upon giving weight to different functional recitations, the Examiner insists that the functional

recitations can be ignored as lacking patentable weight in terms of the 35 U.S.C. § 103 rejection. If the functional limitations can be given no patentable weight in terms of defining the “invention,” they clearly cannot be given patentable weight and specifically relied upon to establish a lack of unity of “invention.”

Besides repeating the errors of the previous improper final Actions as to the improper rejections under the second paragraph of 35 U.S.C. § 112 and associated rationales, and violating the above-noted requirements of 37 C.F.R. § 1.104(c)(2), MPEP § 706.07(a), MPEP § 707.07(d) and MPEP § 707.07(f), the present outstanding final Action further violates 37 C.F.R. § 1.104(c)(2) by failing to clearly explain the pertinence of Ishiguro with regard to the rejection under 35 U.S.C. § 103(a) over Ishiguro. In this regard, when the pertinence of an applied reference is not apparent it must be “clearly explained” (emphasis added).

The outstanding improper final Action further presents conflicting statements as to the facts that have been found as to Ishiguro. For example, pages 13-14 of the present final outstanding Action alleges that “Ishiguro discloses ... a content reproducing device that is structurally arranged to read out an accounting ID identifying money information from a prepaid card.” However, no such disclosure appears at the noted locations (Fig. 1; col. 6, lines 50-65; col. 7, lines 1-3). In addition, this statement is in direct conflict with the first full paragraph on page 14 of the present outstanding Action. In this respect, this page 14 paragraph expressly states that the requirement that the content reproduction device must “read out an accounting ID identifying money information from a prepaid card” is not disclosed by Ishiguro. Making such conflicting findings of facts is submitted to be a clear error and not the required clear explanation of the pertinence of Ishiguro that is required by 37 C.F.R. § 1.104(c)(2).

REQUEST FOR RELIEF

In view of the above statement of facts and the failures of the present outstanding final Action of October 28, 2010, to address or correct the above noted inadequacies, Applicant respectfully requests that the Director exercise his supervisory authority to provide relief by at least requiring that the present outstanding final Action of October 28, 2010, be withdrawn and that all of the above-noted Action inadequacies are corrected in any subsequent Action. Furthermore, in light of the numerous errors associated with the Restriction Requirement, the withdrawal of this clearly improper Requirement is also respectfully requested. Moreover, in light of the protracted improper prosecution and attendant unnecessary costs and delays that have arisen during the prosecution of this application, transfer of this application to a new Examiner is also respectfully requested.

In addition, whether or not this Application is transferred to a new Examiner, Applicant respectfully requests that the Director exercise his supervisory authority to instruct the SPE of Art Unit 3685 to fully comply with MPEP § 707.02 and carefully study any subsequent Office Actions to insure that they properly present any unity of invention requirement in a non-final Action and that all pending claims and only pending claims are treated. In addition, it is requested that the SPE be directed to carefully review any subsequent Actions for completeness under 37 C.F.R. § 1.104(c)(2) as well as to insure that the substance of applicant's arguments is answered as required by MPEP § 707.07(f) and that the requirements of MPEP § 707.07(d) as to the contents of any rejection that is presented are followed. Any subsequent Action should further be reviewed as to compliance with MPEP § 706.07(a).

Finally, it is noted that the last Petition filed in this application on June 3, 2010 appears to have been delegated to the SPE of Art Unit 3685 to author the incomplete decision dated September 9 2010. This decision was clearly incomplete because the correction of the requested inadequacies in any subsequent Action was not addressed. In addition, the request that the SPE be instructed to fully comply with MPEP § 707.02, not the Examiner, was not properly treated in the decision. It is respectfully submitted that as this Petition again requests that supervisory authority be exercised over the SPE of Art Unit 3685, the delegation of this petition to this SPE to author a decision would be improper.

CONCLUSION

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Depositor Account No. 02-2448.

Dated: January 28, 2011

Respectfully submitted,

By 

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